

REMARKS

This amendment is responsive to the office action dated February 15, 2008. Applicants are submitting a Request for Continued Consideration (RCE) with this Preliminary Amendment. Claims 1-28 and 30-33 are pending and stand rejected. By this amendment, Claims 1, 14 and 27 are amended. The scope of all the remaining rejected claims 1-9, 11-22, 24-28 and 30-33 are amended to highlight the distinctions with prior the prior art cited. Reconsideration of the rejected claims is respectfully requested based on the following arguments.

35 U.S.C. § 103 Rejections

In paragraph 7 of the office action, the Examiner indicates that claims 1-28 and 30-33 are rejected under 35 U.S.C. Section 103 (a) as unpatentable over Watanabe et al. (U.S. Patent No. 6,850,757) and Mousseau et al. (U.S. Patent Application Publication No. 2002/0120696). Respectfully, Applicant requests the Examiner to reconsider his rationale for combining the references based on the standard set by the Supreme Court for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” But, that standard is not controlling. Instead the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether **the improvement is more than the predictable use of prior art elements according to their established functions.**

The Supreme Court in *KSR* also stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that **each of its elements was independently known in the prior art.**

The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to **look to interrelated teachings of multiple patents**; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court stated in *KSR* that:

The Court [in *United States v. Adams*, 383 U.S. 39, 51-52 (1966)] relied upon the corollary principle **that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.**

Applicants respectfully submit that Watanabe does not teach certain necessary aspects of the invention and in fact teaches limitations that the present invention functions without. Specifically, Watanabe at column 3, lines 43 – 54, states: “*the user is required to set the mail notification apparatus 100 to request for transmitting the arrival notification mail to the cellular phone,*” this is not a requirement. Rather the mail server automatically sends to the notification server. Additionally, Watanabe states at column 3 line 63 – column 4 line 3:

As described above, if the transmission of the arrival notification mail is set, the mail notification apparatus 100 monitors whether a predetermined period has elapsed. When the predetermined period has elapsed (ST401), the mail notification apparatus 100 establishes a connection to the local mail server 102 (ST402). It is assumed that an IP address of the local mail server 102 is previously set to the mail notification apparatus 100.

The present invention on the contrary has the mail server forward the messages automatically to the notification server as apposed to requiring the notification server to connect to the mail server. This is a significant distinction.

The Examiner has suggested combining Watanabe with Mousseau because the Examiner recognizes that “Watanabe does not specifically disclose generating a copy of said electronic mail message, therefrom, a subset of the received copy of the electronic mail message.” However, the Examiner alleges that “Watanabe does teach notification apparatus (100, fig. 1,) generating and notifying arrival of notification mail message to the wireless device (col 2, lines 24-60) and further suggest adding couple of short sentences to the notification message (col 5,

lines 22-31).” The Examiner cites Mousseau for a teaching of generating a copy of the electronic mail message. Watanabe is distinct for the reasons demonstrated above and Mousseau does not teach generating a copy of the electronic mail message in the context of the claimed invention. Moreover, Applicants note that Mousseau has a filing date of April 6, 2001, less than a month before the filing date of the present invention. Given the usual time of at least a few weeks to prepare the patent application, the present invention was clearly invented well before the filing date of April 6, 2001. Accordingly, neither Watanabe nor Mousseau, alone or in combination teach the claimed inventions.

By this preliminary amendment, claims 1, 14 and 27 are amended to provide further specificity to emphasize the distinctions from the asserted art.

Conclusion

Applicants respectfully request the Examiner to consider the amendments and legal reasoning urged here and to allow this application. In the event the Examiner requires further specificity to distinguish the asserted art, he is respectfully requested to call the undersigned to resolve any issues that remain before allowing this application to pass to issue.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: August 15, 2008

By: /Reena Kuyper/
Reena Kuyper
Registration No. 33,830

9255 Sunset Blvd., Suite 810
Los Angeles, CA 90069
(310) 247-2860